IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UMAC, Inc., Opposer, v. Upside Software, Inc., Applicant.	No. 91160262 APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO STRIKE OPPOSER'S NOTICE OF OPPOSITION

Applicant Upside Software, Inc. requests that the Board grant Applicant's Motion to Strike Opposer's Notice of Opposition for Failure to Sign the Pleading ("Motion to Strike") for two reasons: (1) Opposer, UMAC, Inc.'s, opposition to Applicant's Motion to Strike is untimely; and (2) even if Opposer had filed its opposition within the allowed time, Opposer's opposition fails to state a valid legal basis for denying Applicant's Motion to Strike.

BACKGROUND

On June 1, 2004, Applicant filed its Motion to Strike Opposer's opposition to Applicant's application to register the mark "UPSIDE." On July 6, 2004, Opposer, through its attorney, Simor L. Moskowitz of Jacobson Holman, PLLC, filed an opposition to Applicant's Motion To Strike. Opposer's opposition thus was filed 35 days after Applicant filed its original motion.

In Opposer's opposition to Applicant's Motion to Strike, Opposer argued that "notice" of a defective pleading, for purposes of construing Rule 11(a) of the Federal Rules of Civil Procedure, means notice only "by the [Trademark] Office." Opposer's argument is that a notice of defect provided by Applicant's counsel cannot be effective under applicable law. *See*, Opposer's Opposition to Applicant's Motion to Strike; 37 CFR § 2.119(e). Opposer's argument is unavailing, however, in light of recent United States Supreme Court precedent.

CHRISTENSEN O'CONNOR JOHNSON KINDNESS PLLC
LAW OFFICES
1420 Fifth Avenue, Suite 2800
Seattle, WA 98101-2347
TELEPHONE: 206.682.8100

ARGUMENT

I. Opposer's Response is Late by 15 Days and Under the Rules Must Not be Considered

Trademark Rule 2.119(c), 37 C.F.R. § 2.119(c) requires that: "[a] brief in response to a motion, except for a motion for summary judgment, **must be filed within 15 days from the date of service of the motion** (20 days if service of the motion was made by First Class Mail, "Express Mail" or overnight courier)." *See* T.B.M.P. § 502.02(b) (emphasis added).

In accordance with the Board's rule, Opposer's opposition to Applicant's motion was due on June 21, 2004. Opposer did not file its opposition until July 6, 2004; **15 days late**. Under the Rules, Opposer's opposition is untimely. The Board should not consider this untimely filing, and the Board should grant Applicant's Motion to Strike.

II. Opposer Failed to Correct Its Pleading After Notice By Applicant's Counsel

Even if the Board were to consider Opposer's untimely opposition to Applicant's Motion to Strike, the argument Opposer makes in its opposition is unavailing, in light of recent United States Supreme Court precedent.

Opposer attempts to cure the defect in its original Notice of Opposition by submitting, together with its untimely response, a signed copy of its original Notice of Opposition. In support of this submission, Opposer relies upon trademark rules and the T.B.M.P. for the principle that Opposer has no obligation to cure a defective pleading unless and until the *Trademark Office* notifies it of the defect. The notice provided by Applicant, in Opposer's view, was ineffective as a matter of law.

In making this argument, Opposer blithely ignores the recent United States Supreme Court decision in *Scarborough v. Principi*, 124 S. Ct. 1856, 2004 U.S. LEXIS 3243 (May 3, 2004) cited in Applicant's Motion to Strike. Opposer ignores this precedent at its peril, because any decision by the TTAB is ultimately reviewable by the Supreme Court.[1] In

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1 The Federal Circuit has non-exclusive jurisdiction over TTAB appeals. *See* 15 U.S.C. § 1071(a)(1) (1988). All federal circuit courts of appeals, including the Federal Circuit, are under obligation to follow the precedent of the Supreme Court. *See Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 839 n.2 (Fed. Cir. 1992).

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Scarborough, the Supreme Court reaffirmed that an unsigned and therefore defective pleading could be cured if and only if it is "corrected *promptly after being called to the attention of the attorney or party*." *Id.* at 1866; FED. R. CIV. PROC. 11(a) (emphasis supplied). Neither the Federal Rule, nor the *Scarborough* decision place any limits on the manner in which the attorney or party learns of a defective pleading. A defect need merely be "called to the attention" of the "attorney or party." Neither Rule 11(a) nor *Scarborough* refer to the sort of formal "notice" that Opposer insists upon. Opposer's argument ignores the Federal Rules, and the Supreme Court, and should not be considered by the Board.

Nor can Opposer merely rely upon the fact that its attorney's name appears in *typewritten* form on Opposer's original Notice of Opposition. As the *Scarborough* Court noted, its own precedent defines a "signature" as one placed by hand and not by machine:

> Without any rule change so ordering, however, we are not disposed to extend the meaning of the word "signed," as that word appears in Civil Rule 11(a), to permit typed names. As Rule 11(a) is now framed, we read the requirement of a signature to indicate, as a signature requirement commonly does, and as it did in John Hancock's day, a name handwritten (or a mark handplaced).

Becker v. Montgomery, 121 S.Ct. 1801, 1806, 532 U.S. 757, 764 (2001).

CONCLUSION AND RELIEF REQUESTED

As pointed out in Applicant's opening Motion to Strike, Applicant gave Opposer ample opportunity to correct the defect in its Notice of Opposition. Opposer ignored this opportunity, instead formulating an ineffectual argument why it allegedly had no obligation to cure its defective pleading.

And, it presented this ineffectual argument in an opposition *filed fifteen days late*. Thus either because Applicant's Motion to Strike is untimely and therefore unopposed, or, because Opposer's argument is ineffectual, the Board should grant Applicant's Motion to Strike, and allow Applicant's application to proceed to registration.

CHRISTENSEN O'CONNOR JOHNSON KINDNESS PLLC
LAW OFFICES
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Applicant therefore requests that the Board grant it the following relief: (1) striking Opposer's opposition to Applicant's Motion to Strike; (2) regarding Applicant's Motion to Strike as unopposed and therefore granting it; (3) dismissing Opposer's Opposition; and (4) allowing Applicant's UPSIDE mark to proceed to registration.

Respectfully submitted this 21st day of July 2004.

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS PLLC

Gregory F. Wesner
Everett E. Fruehling
Attorneys for Applicant
Upside Software, Inc.

Certificate of Mailing

I hereby certify that this Applicant's Reply to Opposer's Opposition to Applicant's Motion to Strike Opposer's Notice of Opposition is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on the below date.

Date: July 21, 2004 M Beatty

Certificate of Service

I hereby certify that a copy of this Applicant's Reply to Opposer's Opposition to Applicant's Motion to Strike Opposer's Notice of Opposition is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to:

Simor L. Moskowitz, Esq.
Jacobson Holman PLLC
400 Seventh Street NW
Washington DC 20004

Date: July 21, 2004 M Beatty

EEF:GFW

CHRISTENSEN O'CONNOR JOHNSON KINDNESS PLLC
LAW OFFICES
1420 Fifth Avenue, Suite 2800
Seattle, WA 98101-2347
TELEPHONE: 206.682.8100